

**REMARKS**

This Amendment is submitted in response to the Office Action dated August 29, 2003. In the Office Action, the Patent Office rejected Claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over *Main* (U.S. Patent No. 5,618,064) in view of *Walz* (U.S. Patent No. 5,501,393).

Applicant notes with appreciation that the Patent Office indicated that Claims 8-16 and 21 are in allowable form. To this end, Applicant added Claim 22 incorporating Claim 8 with Claim 1. Applicant submits that new Claim 22 is, therefore, in allowable form. Notice to that effect is respectfully requested.

With respect to the rejection of Claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over *Main* in view of *Walz*, Applicant submits that the rejection has been overcome in view of the foregoing amendment and the remarks that follow. Notice to that effect is requested.

In the Office Action, the Patent Office alleges:

*Main* discloses in Fig. 1 and 2, a mailing assembly comprising: a backing sheet (200) forming a transparent compartment to be adhered to a mailpiece (Col. 2 lines 52-59) having an opening (214) wherein the form is capable of entering); a mail form (100, Col. 2, lines 60-67, and Col. 3, lines 1-3 that is removably attached to the backing sheet and further wherein the mailing form is variably printed with information (104-114); wherein the form is inserted into the compartment to effect delivery of the mailpiece (Col. 3, lines 11-20); and wherein the mail form has a mailing label section (100), and a non-adhesively attached receipt portion (112).

However, *Main* does not disclose that the receipt is detachably connected to the mailing label section.

*Walz* discloses in Fig. 1-5, a mailing form (12, and section 84) comprised of a non-adhesive receipt (84), wherein the receipt is removably attached to a backing sheet (14) and is detachably connected (through perforated lines, 24 and 26) to the mailing label (12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Main's* mailing form to include a detachably connected receipt portion as taught by *Walz* for the purpose of providing a confirmation notice which can be mailed back to the sender.

However, independent Claim 1, as amended, requires a mailing assembly for use in connection with a non-domestic delivery of a mailpiece holding contents for delivery having a backing sheet which has a first section and a second section with an adhesive. The backing sheet forms a compartment having an interior space formed by attaching the second section to the first section with the adhesive. Additionally, the adhesive attaches the compartment to the mailpiece. Further, Claim 1 requires the mailing form to be inserted into the interior space of the compartment to effect non-domestic delivery of the mailpiece. Still further, Claim 1 requires the receipt card to have no adhesive, be removably attached to the backing sheet, and be detachably connected to the mailing label.

Contrary to the assertions of the Patent Office, *Main* merely teaches a packing slip and shipping label for use on a package. The packing slip has a front side having an area where a destination is contained and printed. The shipping label has a

top side and a bottom side. The bottom side is adhesively coated and adhered to the packing slip. The shipping label is removed from the back side of the packing slip. The packing slip is folded such that the destination is visible, and the folded packing slip is placed next to the bottom side of the shipping label. The shipping label is affixed to the package via an adhesive coating adhered to the shipping label.

Furthermore, *Walz* merely teaches a multi-part mailing form which has two superimposed sheets of material, such as paper stock, which are secured together in adhered areas by an adhesive layer between the sheets. The inner face of a lower sheet is coated with a non-adhesive material in certain areas so that the sheets are not adhered in these areas. Tear lines extend through both sheets allowing sections of the form to be separated from one another. One of the separable sections has imprinted indicia on the outer face of each sheet and includes an adhered area of the form with a return postcard for confirming receipt of a mailed item.

Neither *Main* nor *Walz*, taken singly or in combination, teach or suggest a mailing assembly having backing sheet which has a first section and a second section with an adhesive wherein the backing sheet forms a compartment which has an interior space formed by attaching the second section to the first section with the adhesive as required by Claim 1. *Main* merely teaches that "the shipping label, with the destination information preferably

showing therethrough, is affixed to the package and secured thereto via the adhesive coating adhered along the peripheral edges of the shipping label." (See *Main*, col. 3, lines 16-19.) Clearly, therefore, *Main* does not teach or suggest that the shipping label 200 forms a compartment having an interior space formed by attaching a second section of the shipping label 200 to the first section of the shipping label 200 with an adhesive as required by Claim 1. Nowhere does *Walz* teach or suggest a mailing assembly having a backing sheet having a first section and a second section with an adhesive wherein the backing sheet forms a compartment as required by Claim 1.

Neither *Main* nor *Walz*, taken singly or in combination, teach or suggest a mailing assembly having a mailing form which is inserted into the interior space of the compartment to effect non-domestic delivery of the mailpiece as required by Claim 1. *Main* merely teaches that "the packing slip 100 is folded such that the destination is visible and is placed next to the bottom side of the shipping label and the shipping label is affixed to the package." (See *Main*, col. 3, lines 11-18.) Clearly, therefore, *Main* does not teach or suggest that the packing slip 100 is inserted into the compartment as required by Claim 1. Nowhere does *Walz* teach or suggest a mailing assembly having a mailing form which is inserted into the interior space of the compartment as required by Claim 1.

Further, neither *Main* nor *Walz*, taken singly or in combination, teach or suggest a mailing assembly having a receipt card which has no adhesive, is removably attached to the backing sheet and is detachably connected to the mailing label as required by Claim 1. *Main* merely teaches that "the front side of the packing slip 100 includes a purchase order number 106, freight airbill number 108, freight charges 110, certain shipper information 112, and shipper remarks 114." (See *Main*, col. 2, lines 25-88.) Contrary to the assertions of the Patent Office, *Walz* merely teaches that "the upper sheet 12 and the lower sheet 14 have an adhesive layer 16 between them for adhering the upper sheet to the lower sheet in certain areas." (See *Walz*, col. 2, lines 58-60.) Further, *Walz* teaches that "the front sheet and rear sheet are only adhered together in the return postcard part of the form in the region between tear lines 24 and 26." (See *Walz*, col. 4, lines 42-45.) Clearly, therefore, neither *Main* nor *Walz*, taken singly or in combination, teach or suggest a mailing assembly having a receipt card which has no adhesive, is removably attached to the backing sheet and is detachably connected to the mailing label as required by Claim 1.

Moreover, a person of ordinary skill in the art would never have been motivated to combine the teachings of *Main* with *Walz* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). More specifically, Applicant submits that the Patent Office is merely "piece-mealing"

references together, providing various teachings and positively defined limitations of Applicant's mailing assembly to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is impermissible. Applicant respectfully submits that Claim 1 distinctly defines the present invention from *Main* and *Walz*, taken singly or in combination.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entirieties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Main* and *Walz* in mind, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art at the time of Applicant's invention would have been led to combine *Main* with *Walz* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the *Main* and *Walz* still lack the novel features and structural relationships positively recited in Claim 1. Namely, neither *Main* nor *Walz*, taken singly or in combination, teach or suggest a mailing assembly having a backing sheet which forms a compartment to be adhered to the mailpiece as required by Claim 1. Further, neither *Main* nor *Walz*, taken singly or in combination, teach or suggest a mailing assembly having a mailing form which is inserted into the compartment to effect non-domestic delivery of the mailpiece as required by Claim 1. Still further, neither *Main* nor *Walz*, taken singly or in combination, teach or suggest a mailing assembly having a receipt card which has no adhesive, is removably attached to the backing sheet and is detachably connected to the mailing label as required by Claim 1. Accordingly, the rejection of Claims 1-7 under 35 U.S.C.

§103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-7 depend from Claim 1. These claims are further believed allowable over the references of record for the same reasons set forth above with respect to their parent claim since each sets forth additional structural elements of Applicant's mailing assembly for use in connection with a non-domestic delivery of a mailpiece holding contents for delivery.

In view of the foregoing remarks, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is now in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,



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**CERTIFICATE OF MAILING**

I hereby certify that this **AMENDMENT** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 29, 2003.



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